

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
John W. Carbone et al.

Serial No.: 10/064,665

Filed: August 5, 2002

For: System and Method for Providing
Asset Management and Tracking
Capabilities

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§ Examiner: Sheikh, Asfand M.
§
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February 23, 2009	/Florin C. Faries/
Date	Florin C. Faries

REPLY BRIEF

This Reply Brief is being filed in response to the Examiner's Answer mailed on December 22, 2008.

The Examiner rejected the only two independent claims 1 and 26 based on the combination of Marsh and Maltseff. Claims 1 and 26 claims recite both a “remote client computer” and “at least one interrogation device” operatively connected to the remote client computer system, “wherein the at least one interrogation device is separate from the remote client computer system.” (Emphasis added).

Applicants initially stress that the cited combination does not teach or suggest all of the elements of claims 1 and 26. For example, the cited combination does not disclose a remote client computer, as claimed. Marsh discloses a field control device 110 and Maltseff discloses a personal computer 20. Neither reference indicates that such devices are a remote client computer. For this reason alone, the Examiner has not established a *prima facie* case of obviousness. Accordingly, the foregoing rejection should be withdrawn and the claims allowed.

Further, Applicants believe there is no appropriate reason to modify Marsh to separate or add to the Marsh components, as apparently proposed by the Examiner. *See, e.g.,* Examiner’s Answer, pages 4-5. The Examiner contended that the Marsh field control device 110 reads on both elements of the present claims of a “remote client computer” and “at least one interrogation device.” Yet, the Marsh field control device 110 is a “computing device [a hand-held computing device] advantageously connected to a transmission device [an antenna].” *See* Marsh, paragraph 21. An antenna cannot be characterized as an interrogation device, as claimed. Further, the computing device 110, even if modified, cannot be characterized as separate devices of a client computer and an interrogation device, as claimed.

In the Advisory Action, the Examiner stated that the motivation for the combination was in order to allow for tracking information via a wireless memory device and storing the information as a central computer system. Appellants respectfully disagree that such motivation exists. First, Appellants respectfully assert that the Examiner’s analysis is conclusory and confusing. Second, Marsh already teaches a

wireless memory device: the computing system (e.g., a PDA) of the field control device 110. *See* Marsh, paragraph 0021. Third, Marsh teaches away from storing information on a central computing system. *See, e.g.,* Marsh, Abstract and paragraph 0007. Thus, the foregoing rejection is deficient for at least these reasons and the present claims should be allowed.

It should be emphasized that present claims recite both a *remote client computer* and an *interrogation device*, of which these devices are separate from one another. In contrast, again, the Marsh field control device 110 is a single device. To be sure, the device 110 which is a hand-held computing device connected to an antenna cannot be characterized as both a remote client computer and an interrogation device which are separate from each other, even if the Marsh device 110 is modified to separate the antenna from the computing device, and even if this modification of Marsh was appropriate (which Appellants do not concede). *See KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) (“[R]ejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoting *In re Kahn*, 441 F.3d 977,988 (Fed. Cir. 2006)).

The Examiner relied on the secondary reference (Maltseff) to modify the Marsh system to apparently split the Marsh computing and transmission device, and to have this split device read on both the *remote client computer* and the *interrogation device* of the present claims. First, the “transmission device” (an antennae) of Marsh, is said to be “advantageously connected” to the computing device. To be sure, the Examiner has not explained the feasibility of such a modification of Marsh, or why one of ordinary skill in the art would go against the teachings of Marsh to separate these two components of the Marsh field device 110. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Second, one of ordinary skill in the art would not add the unnecessary component of a remote client computer to the Marsh system to be coupled to Marsh computing device or to the antenna. Likewise, the skilled artisan would not add an interrogation device to be added to the Marsh system to be coupled to Marsh computing device or to the antenna. Such a hypothetical remote client computer and/or interrogation device in the Marsh system would not advance any purpose of the Marsh system, and would add unnecessary expense and complexity.

In conclusion, the Examiner relied on the Marsh and the secondary reference (Maltseff) to teach a field control device operatively connected to an asset management system and further the remote client computer system contains at least one interrogation device that is separate from the remote client computer. See Examiner's Answer, page 5. However, the Examiner provided no reasonable explanation or appropriate reason to modify Marsh. The Supreme Court has stated that the obviousness analysis should be explicit. See *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007). In the present rejection, the Examiner has failed to meet this requirement of the obviousness analysis, and therefore has not established a *prima facie* case of obviousness. Further, Appellants strongly believe that there is not an appropriate reason to modify Marsh in such a way as to read on independent claims 1 and 26. For these reasons, Appellants respectfully request the Board direct the Examiner withdraw the rejection and allow the claims.

Dependent Claims

Dependent claim 3 recites wherein the at least one interrogation device includes a fixed radio frequency identification tag reader. Dependent claim 4 recites wherein the at least one interrogation device includes a handheld radio frequency identification tag reader. Lastly, dependent claim 4 recites wherein the handheld radio frequency identification tag reader is a handheld computing device. Conversely, Appellants believe

it inappropriate to modify Marsh such that the Marsh transmission device is one of the devices recited in claims 2-4. After all, such a device is not needed in the Marsh system. It would not make sense to have both the Marsh computing device and a radio frequency identification tag reader. Likewise, it would not make sense to replace the Marsh computing device with a radio identification tag reader and to have a separate transmission device or antenna. There is simply no appropriate reason to have both a separate computing device (or remote client computer, as claimed) and a separate radio frequency identification tag reader, as claimed. Thus, for these additional reasons, the Examiner has not established a *prima facie* case of obviousness with regard to dependent claims 3-5. Accordingly, dependent claims 3-5 are patentable over the cited combination for these additional reasons, and the claims should be allowed.

Lastly, the Examiner's use of Official Notice does not obviate the deficiencies of the cited combination of Marsh and Maltseff with regard to the independent claims discussed above. Therefore, the dependent claims 7, 15, 32, and 40 are believed to be patentable for at least the reason of their dependency on an allowable base claim. Accordingly, Appellants respectfully request the Board direct the Examiner to withdraw the rejection and allow the claims.

Further, claim 7 recites "at least one *legacy database system* operatively connected to the asset management server computer system." (Emphasis added). The cited combination is absolutely devoid of this feature. In addition, the Examiner's use of Official Notice is improper. Indeed, the Examiner has not reasonably argued or provided evidence to support his assertions of "well-known" facts which must be of a "notorious character" and "capable of such instant and unquestionable demonstration as to defy dispute." See M.P.E.P § 2144.03. Appellants believe that it not well-known to couple a legacy system into the Marsh system, in the manner asserted by the Examiner or in the manner recited in claim 7. For this additional reason, the Examiner has not established a

prima facie case of obviousness with regard to claim 7. Accordingly, the rejection of claim 7 should be withdrawn and claim 7 allowed.

Conclusion

Appellants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner or Board wishes to resolve any other issues by way of a telephone conference, the Examiner or Board is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: February 23, 2009

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